

TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

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Serial No. 75/835,499

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Mark: EMD

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BRIEF FOR APPELLANT

I. INTRODUCTION

Applicant appeals from the Examining Attorney's final refusal to register Applicant's EMD service mark ("Mark") on the grounds that it is likely to cause confusion, mistake or to deceive. Applicant respectfully requests the Trademark Trial and Appeal Board ("Board") to reverse the Examiner's decision and pass the application to publication. Applicant has filed a timely Notice of Appeal. Applicant does not seek oral argument in this appeal.

II. RECITATION OF SERVICES:

Applicant has twice amended the recitation of services based in part upon the suggested language provided by the Examiner. Despite amending the recitation to coincide with the Examiner's suggestions, Applicant's recitation continues to be refused on the grounds that it is unclear and indefinite. Applicant did not

adopt the exact language proposed by the Examiner as it did not fully describe the nature of Applicant's services. Essentially, Applicant's services are comprised of a user-friendly website wherein the site accepts user input describing various medical ailments and symptoms to which Applicant's service will analyze the symptoms and provide the user information as to the nature of the condition and recommended forms of treatment.

Specifically, the Examiner takes exception with the terminology "diagnostic services in the field of health and medicine" (see Office Action dated September 19, 2002). Applicant respectfully points out that the language in question, "diagnostic services in the field of....." is taken directly from the USPTO Trademark Acceptable Identification of Good and Services Manual (see Exhibit A, attached hereto and incorporated herein by this reference). Applicant is unclear why the Examiner has rejected language which has been expressly approved and illustrated as model language by the USPTO. Accordingly, Applicant resubmits the amended recitation of services as it appeared in Applicant's February 27, 2001 Response, said amendment to read in its entirety:

"On-line information services, namely, providing information, databases and diagnostic services in the field of medicine and health care" in International Class 42.

In the alternative, should the Board concur with the Examiner that the above recitation of services is not acceptable, Applicant amends the recitation in accord with the express language proposed by the Examiner in her August 31, 2000 Office Action, said amendment to read in its entirety:

On-line information services, namely, providing databases and informational website links to other content provides in the field of medicine and health care" in International Class 42.

III. LIKELIHOOD OF CONFUSION:

Factors relied upon by Applicant in determining likelihood of confusion include those set forth in *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Applicant seeks registration on the Principal Register of its Mark "for on-line information services, namely, providing information, databases and diagnostic services in the field of medicine and health care."

The Examiner has refused registration under the Trademark Act § 2(d), 15 U.S.C. 1052(d), based upon prior Federal Registration No. 2,129,111 for e.MD (stylized) for a "publication, namely, a magazine covering information in the medical and healthcare fields" and "arranging and conducting educational conferences in the medical and healthcare fields" ("Registration" or "Registrant"). The Examiner has stated that the similarities between the marks and goods/services could potentially result in the likelihood of confusion. These concerns are respectfully traversed for the reasons set forth below.

A. Applicant's Mark is Sufficiently Different in Commercial Impression from Registrant's Mark as to Preclude any Likelihood of Confusion.

The marks in question are the Applicant's typed form "EMD" mark and the stylized "e.MD" of Registrant (see Exhibit B, attached hereto and incorporated herein by this reference). In her September 25, 2002 Office Action the Examiner states that the marks are virtually identical largely due to the fact that Applicant has not limited its rights to a particular typestyle or design element. The Examiner believes that Applicant could conceivably adopt a typestyle identical to Registrant. This assessment is respectfully traversed by Applicant as it is believed that the marks bear a sufficiently distinct connotation and overall commercial impression as to obviate all likelihood of confusion concerns.

While the Examiner correctly infers that she must look at the marks for similarities in appearance, sound, connotation and commercial impression, the instant rejection appears to be based solely on the fact that both marks have the common letters "e," "m," and "d." Although Applicant acknowledges the similarity arising from use of the same letters, Applicant submits that his Mark, EMD, conveys a different specific meaning and impression than that presented by Registrant's stylized e.MD. Under the "anti-dissection" rule, conflicting marks must be compared in their entireties to determine a likelihood of confusion. *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538 (1920). The likelihood of confusion analysis requires that the Examiner consider the impression that the mark *as a whole* creates on the average, reasonably prudent buyer.

While the Examiner asserts that the presence of the "dot" between the "e" and the "MD", the incorporation of the stylized lettering, and the use of "e" in lower case does not distinguish the marks, Applicant

respectfully disagrees. As illustrated in Exhibit B, the marks appear significantly different as Registrant's "dot" serves as a visual interruption between the "e" and the "MD" coupled with shadowed stylized letters. Mentally, the marks sound different as Registrant's mark is pronounced "E-DOT-MD" whereas Applicant's is pronounced "EMD". Registrant's incorporation of the "dot" gives its mark a specific meaning and distinct impression not found in Applicant's Mark, that is, the "psychological imagery" evoked by the respective marks overpowers the respective similarities in appearance. *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 156 USPQ 340 (CCPA 1968). See *In re Software Design, Inc.*, 220 USPQ 662 (TTAB 1983) (DOX and DOC'S, both for software, not likely to cause confusion), and *In re Conti*, 220 USPQ 745 (TTAB 1983) (SHEAR PERFECTION for beauty salon services not confusingly similar to SHEER PERFECTION for leg makeup).

Applicant respectfully draws the Board's attention to the following cases where a mark was registered even though it incorporated the registered mark of another:

1. VA for tomato juice does not resemble V-8 for vegetable juice such that confusion is likely. *Standard Brands, Inc. v. Eastern Shore Canning Co.*, 80 USPQ 318 (4th Cir. 1949).
2. VIE for liquid detergent not likely to cause confusion with VIM for cleansing powder. *Lever Brothers, Co. v. Winzer Co. of Dallas*, 140 USPQ 247 (CCPA 1964)
3. NECS for computer chips not likely to cause confusion with NEC for electronic components. *NEC Electronics v. New England Circuit Sales, Inc.*, 13 USPQ2d 1058 (D. Mass. 1989).
4. HOLIDAY OUT for recreational vehicle parks was found not to resemble HOLIDAY
5. INN for motels such that confusion is likely. "Holiday" is a common word that is widely used by others; alleged evidence of actual confusion was not substantiated; and defendants' business was not conducted in a manner to suggest a connection between the two marks. *Holidays Inns, Inc. v. Holiday Out in America, et al.*, 178 USPQ 257 (5th Cir. 1973).
6. HEALTH SELECTIONS for shelf-stable foods does not so resemble HEALTHY CHOICE for shelf-stable foods such that confusion is likely. The marks sound significantly different, are relatively weak and there was no intent to confuse the public. *Con-Agra, Inc. v. George A. Hormel & Co.*, 26 USPQ.2d 1316 (8th Cir. 1993).

In these cases, the marks, *when compared in their entireties*, were found not to be confusingly similar. Here, Applicant's "EMD" Mark is collectively different in appearance, sound and commercial impression from Registrant's stylized "e.MD" mark when the marks are compared in their entireties. Though both marks share

the letters “e”, “m” and “d,” Applicant submits that based upon the visual differences resulting from the incorporation of the “dot”, the use of a lower case letter, the stylized lettering, and the shading, the two marks differ in terms of appearance, connotation and commercial impression.

As noted by the Federal Circuit in *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336 (Fed. Cir. 1984), where two marks share identical portions that play a dominant role, resolution of the issue of likelihood of confusion hinges on what if any distinction is afforded by the additional matter found in each mark. In *Colony*, the Federal Circuit upheld a Board ruling that the mark “Hobo Joe’s” was not confusingly similar to “Hungry Hobo” for identical restaurant services. In so holding, the Board (and the Federal Circuit) noted that the connotation of “Hobo Joe’s” designated a particular person of the itinerant or vagrant persuasion while the connotation of “Hungry Hobo” was that of an anonymous vagrant in need of a meal. *Id.* The distinctions between Applicant’s Mark and the Registration are directly analogous in light of Registrant’s “dot” connotation and visual design elements.

Applicant further notes that the degree of similarity of the marks needed to prove likely confusion will vary with the difference in the goods and services of the parties. Where the good and services are not directly competitive (Section B herein), the degree of similarity required to prove likelihood of confusion is greater than in the case of highly similar products. See *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698 (Fed. Cir. 1992). For this reason and the arguments set forth above, Applicant submits that any likelihood of confusion between the marks is, at most, *de minimus*.

B. Applicant’s Services are Sufficiently Different and Unrelated to Registrant’s Goods/Services as to Preclude Likelihood of Confusion.

The principal basis for the Examiner’s conclusion as to likelihood of confusion, aside from the perceived similarity in appearance between Applicant’s Mark and the mark of Registrant, is that there is a commercial relationship between on-line diagnostic services and magazines/seminars. Applicant believes that there is no such relationship. Applicant is unaware of any cases holding that there is a *per se* commercial relationship between on-line medical diagnostic services and magazines/seminars. None of the cases cited by the Examiner

involve on-line diagnostic services, on the one hand, and magazines/seminars, on the other.

The Examiner's concern regarding likelihood of confusion is an excessively broad interpretation of the related goods doctrine. It is difficult to fathom how consumers are likely to confuse Applicant's on-line diagnostic services (Applicant's on-line service identifies illness and particular medical conditions based on user input and recommends course of treatment for the illness or condition) with Registrant's print magazines and conference services. The Examiner apparently concludes that because the respective goods and services relate to medical and health fields that confusion is likely. In the September 25, 2002 Office Action, the Examiner states:

The goods and services of each of the parties provide medical and health care information and, as such, are highly related goods and services, and are of a type that would be within the natural zone of expansion of the parties' goods and services.

No proof is given by the Examiner that on-line diagnostic services and health magazines and conferences are offered or merchandised by the same source in a way that would lead to a public conclusion said goods and services are commercially related. There is no evidence in the record that any one company provides both types of goods and services under the same mark, or would be expected to. The Examiner assumes, without any factual support or substantive discussion, that the goods and services are related because they are both directed to the health and medical industry. Such an assumption is an excessively broad interpretation of the related-goods doctrine.

Applicant's services are limited solely to on-line medical diagnosis. Applicant's services are completely different from Registrant's health magazine and medical seminars. The respective goods and services function differently, serve different needs and are not competitive with one another. Two critical components of Applicant's service are: 1) it is an on-line database; and 2) it requires user input and provides feedback which is directly responsive to that input. There has been no showing that Registrant's magazine or conferences touch upon or are related to these components. In fact, a print magazine and a seminar/conference is an entirely different medium from Applicant's on-line forum. A magazine includes predetermined articles which are distributed via the mail or newsstand purchase. A seminar/conference includes a predetermined topic which is

addressed by a live speaker in front of a live audience. Applicant's service *electronically* receives medical condition and symptom input from users and, based upon that input, *electronically* provides diagnosis relevant to the medical condition or symptom data. Applicant draws the Board's attention to *Primedia Intertec Corp. v. Technology Marketing Corp.*, 50 USPQ2d 1079 (DC Kan 1998) where print magazines and website magazines were held to be unrelated as the website required computer access. *Primedia* falls squarely on the factual circumstances of the instant case.

The nature of the good/services described in the Registration and Applicant's Mark are dissimilar except that they both relate to the large and diverse health care field. To bar registration of Applicant's mark merely because its services could potentially fall within the periphery of Registrant's goods/services would provide Registrant with an exclusive monopoly for all goods and services that feature information in the healthcare industry. Such is an incorrect interpretation of federal trademark law.

By analogy, Applicant points out that this Board has ruled that with respect to another modern-day industry field, computers, in order to support a likelihood of confusion there must be some similarity between the good and services at issue beyond the fact that each involves the use of computers. *The Reynolds and Reynolds Company v. I.E. Systems, Inc.*, 5 USPQ2d 1749 (TTAB 1987). Such a conclusion was further illustrated in *In re Medical Central Online, Inc.*, 2003 TTAB Lexis 531 (TTAB 2003) where the Board ruled that any software utilized in the healthcare field would always be viewed as related to any healthcare service simply because they are marketed under the same or similar marks (PATIENT NET for providing on-line information as to bed availability in nursing homes not likely to cause confusion with PATIENTNET for healthcare computer hardware, software and patient status apparatus). In line with the reasoning of the Board in *Reynolds* and *In re Medical*, the services of Applicant are substantially dissimilar to those of Registrant and would not give rise to a mistaken belief that the services come from a common source.

It is also the contention of the Examiner that the goods and services of both parties are related as Applicant may engage in rendering the services of Registrant and vice versa. The fallacy with this argument is

that it erroneously presupposes the nature of Applicant's business. Said business does not include magazines or presenting seminars. As stated by the Ninth Circuit:

A likelihood of confusion exists when a consumer viewing a service mark is likely to purchase the services under a mistaken belief that the services are, or associated with, the services of another provider. The confusion must be probable, not simply a possibility. *Murray v. Cable National Broadcasting Co.*, 39USPQ2d 1214 (9th Cir. 1996) (consumer survey services unrelated to talk-show television programming services).

Applicant respectfully points out that the statutory ground for refusal is not whether the goods of the parties may be encountered under circumstances that the goods could come from a common source. The 'may' language connotes only a possibility of confusion. The statute requires that there be a likelihood of confusion. As stated by the Board in *MTD Products, Inc. v. Universal Tire Corp.*, 193 USPQ 56 (TTAB 1976), "a possibility of such confusion always exists, but what may be possible may not at all be probable and, if not probable, it is not likely."

Applicant respectfully draws the Board's attention to the following cases wherein the respective trademarks were held not to be confusingly similar even though the product (or service) had shared similarities, complimentary functions or were derived from the same industry:

ALLSTATE

(insurance)

Allstate Ins. Co. v. Allstate mv. Corp., 141 USPQ 280 (5th Cir. 1964).

ALLSTATE

(mortgage brokerage services)

AG

(floor coating)

American Optical Corp. v. American Ocean Tile, 185 USPQ 405 (SDNY 1974).

AG

(ceramic tile)

AUTUMN

(margarine)

Lever Bros. Co. v. American Bakeries, 216 USPQ 177 (2d Cir. 1982).

AUTUMN GRAIN

(bread)

BENEFICIAL

(consumer loans)

Beneficial Corp. v. Beneficial Capital Corp., 213 USPQ 1091 (SDNY 1982).

BENEFICIAL CAPITAL

(business loans)

BLUE RIBBON

(beer)

BLUE RIBBON

(malt extract)

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BLUE RIBBON

(beer)

Pabst Brewing Co. v. Decatur Brewing Co., 284 F. 110 (7th Cir. 1922).

BLUE RIBBON

(malt extract)

BRAVO'S

(crackers)

Vitarroz Corp. v. Borden, Inc., 209 USPQ 969 (2d Cir. 1981).

BRAVOS

(tortilla chips)

CADET

(storage batteries)

Pep Boys — Manny, Moe & Jack v. Edwin F. Guth Co., 94 USPQ 158 (CCPA 1957).

CADET

(lighting fixtures)

COLUMBIA

(university)

Columbia University v. Columbia/HCA Healthcare Corp., 43 USPQ.2d 1083 (SDNY 1997).

COLUMBIA

(health care services)

CONSUMERS

(fuel oil)

Consumers Petroleum v. Consumers Co. of Illinois, 78 USPQ 227 (7th Cir. 1948).

CONSUMERS

(coal and wood fuel)

DRIZZLER

(men's golf jackets)

McGregor-Doniger, Inc. v. Drizzle, Inc., 202 USPQ 81 (2d Cir. 1981).**DRIZZLE**

(women's overcoats and rain coats)

ESPRIT

(women's shoes)

Lubousky, Inc. v. Esprit de Corp., 228 USPQ 814 (SDNY 1986).**ESPRIT**

(women's clothing)

EXQUISITE

(ladies' undergarments)

Exquisite Form Industries, Inc. v. Exquisite Fabrics of London, 183 USPQ 666 (SDNY 1974).**EXQUISITE**

(fabrics)

FEDERAL

(radio supplies)

Federal Tel. & Radio Corp. v. Federal Television Corp., 84 USPQ 394 (2d Cir. 1950).**FEDERAL**

(television sets)

HURRICANE

(outboard motors)

Kiekhaefer Corp. v. Willys-Overland Motors, Inc., 111 USPQ 105 (CCPA 1956).**HURRICANE**

(auto engines)

KINGSFORD

(charcoal briquettes)

Kingsford Prods. Co. v. Kingsfords, Inc., 11 USPQ.2d 1350 (SDNY 1989).**KINGSFORD**

(barbecue sauce)

Logo Device

(telephone services)

The Alliance Manufacturing Company, Inc. v. Allied Telephone Company, 182 USPQ 237 (TTAB 1974).**Logo Device**

(antenna rotators)

MICRONAUTS

(toys)

Scott v. Mego Int'l, Inc., 213 USPQ 824 (D. Mm. 1981).**MICRO NAUTS**

(hobby items)

MINI CINEMA

(family movie theaters)

Modular Cinemas of America, Inc. v. Mini Cinemas Corp., 175 USPQ 355 (SDNY 1972).**MINI CINEMA**

(erotic movie theater)

OL1

(tequila)

Schenley Distillers, Inc. v. General Cigar Co., 166 USPQ 142 (CCPA 1970).**OL1**

(cigars)

PLAYERS

(shoes)

In re British Bulldog, Ltd, 224 USPQ 854 (TTAB 1984).**RIVA**

(luxury power boats)

Riva Boats Int'l Spa v. Yamaha Motor Corp., 223 USPQ 183 (C.D. Cal. 1983).**PLAYERS**

(men's underwear)

RIVA

(motor scooters)

Riva Boats Int'l Spa v. Yamaha Motor Corp., 223 USPQ 183 (C.D. Cal. 1983).**SUNBEAM**

(electric appliances)

Sunbeam Lighting Co. v. Sunbeam Corp., 86 USPQ 240 (9th Cir. 1950).**SUNBEAM**

(fluorescent lamps)

Sunbeam Lighting Co. v. Sunbeam Corp., 86 USPQ 240 (9th Cir. 1950).**SUNKIST**

(fruits)

California Fruit Growers Exchange v. Sunkist Baking Co., 76 USPQ 85 (7th Cir. 1947).**SUNKIST**

(bakery products)

California Fruit Growers Exchange v. Sunkist Baking Co., 76 USPQ 85 (7th Cir. 1947).**TORO**

(motor vehicles)

Toro Mfg. Corp. v. Gleason Works, 177 USPQ 330 (CCPA 1973).**TOROID**

(gears)

Toro Mfg. Corp. v. Gleason Works, 177 USPQ 330 (CCPA 1973).**X*PRESS**

(for transmitting news and a variety of general information and data to home and business computers via satellite and cable television lines)

Information Resources, Inc. v. X-Press Information, 6 USPQ.2d 1034 (TTAB 1988).**EXPRESS**

(computer software and services relating to the analysis of information, including financial information)

LAZU

(hair salon)

Zazu Designs v. L'Oreal, S.A., 24 USPQ.2d 1828 (7th Cir. 1992).**LAZU**

(hair care product)

Zazu Designs v. L'Oreal, S.A., 24 USPQ.2d 1828 (7th Cir. 1992).

In the present case, Applicant's services are *substantially less* related to the Registrant's goods/services than any of the above-cited cases. On-line medical diagnostic services, on the one hand, and magazine and conducting conference are non-competitive, have little in common, and are not species from the same genus. They are not used or purchased together and are mutually exclusive. Despite the Examiner's assertions to the contrary, there is nothing in the record to indicate that Registrant is likely to bridge the gap and expand its business to compete, even remotely, with Applicant. That the respective goods and services relate to healthcare does

not in and of itself create a likelihood of confusion. Applicant submits that, in the present situation, where the goods and services are so obviously different in their essential characteristics and functions, where such a substantial competitive distance exists between them, and where no evidence supports any belief that they originate from the same source, the refusal to register is improper.

C. Applicant's Channels of Trade and Conditions of Sale are Sufficiently Different as to Preclude Any Likelihood of Confusion.

In comparing the two marks for likelihood of confusion, it also appears that the Examiner has failed to examine the channels of trade and/or the activities surrounding the marketing of the respective goods and services. Applicant's services are for on-line diagnostic services, the function of which is to provide medical diagnosis and treatment based upon user input. Applicant does not publish or sell magazines, does not conduct seminars, nor has Applicant sought to register his Mark for these goods and services.

A consumer would come across Registrant's mark, as it is identified in the registration, as a magazine or on a flier for a continuing medical educational seminar. Applicant's services would be encountered in the marketplace only through the Internet in electronic form rather than the mail or newsstand. While some magazine subscribers and educational conference attendees may seek medical diagnostic services through the Internet, they would not seek those services from Registrant.

In light of the substantial differences between on-line, print magazine and live conference mediums, it is highly unlikely that the goods/services bearing the two marks in question would travel in the same channels of trade and/or the activities surrounding their marketing are such that confusion as to origin is likely. Applicant and Registrant are not

engaged in competitive businesses regarding their respective marks. Applicant markets himself only to individuals seeking medical information that are willing to input data in Applicant's system. In no instance would consumers have the opportunity to compare side-by-side Applicant's services and Registrant's goods/services. There is no evidence that even begins to show that Applicant's and Registrant's trade channels are the same or overlap. There certainly is no evidence in the record that any one company supplies both types of goods and services or would be expected to. The fact that the respective goods and services could be purchased by the same ultimate end user is not enough to warrant a finding of likelihood of confusion. Purchasers would readily distinguish between the two. Applicant draws attention to *In re Fesco*, 219 USPQ 437 (TTAB 1983) wherein use of the same mark on farm distributor services and various types of farm processing machinery was held not to be likely to cause confusion given the distinction of the goods and the fact that there was insufficient evidence that they would be encountered by the same purchaser.

Unlike *In re Fesco*, Applicant's services and the goods and services of Registrant are not competitive or related. The field of health care is extremely broad. Registrant's consumers are likely to be well educated, very discerning, and knowledgeable in the health care profession when purchasing health care magazines or attending seminars on health care topics. On the other hand, Applicant's consumers are seeking treatment or information relating to a medical condition. Applicant's services are directed to a far wider and more general audience than the discerning consumers of Registrant. Because the respective consumers of Applicant and Registrant are motivated by entirely different concerns regarding the purchase of the respective goods and services, and because these goods and services are not impulse items purchased with little care but only careful consideration, the consumers can be categorized as "discriminating"

purchasers and any likelihood of confusion would be de minimus at best.

Applicant respectfully submits that any relationship between his service and Registrant's magazines and conferences is so tenuous that prospective purchasers would not assume a single source or sponsorship. No prospective purchasers of magazines could obtain such from Applicant. Nor is there any evidence of record that prospective purchasers of on-line medical diagnosis could obtain such from Registrant. Thus, Applicant submits that, in the present situation, where the goods have such distinctly different channels of trade and the activities surrounding their purchase are clearly different, the refusal to register is improper.

D. The Term "EMD" is Weak and Entitled to a Narrow Range of Protection.

In further support of Applicant's contention that no likelihood of confusion exists, an additional important factor to consider is the number and nature of identical or similar marks in use on similar goods or services. *In re E.I. du Pont de Nemours Co., supra*. Identified below are numerous federal registrations/passed applications which employ the term EMD or similar formatives (copies attached hereto as Exhibit C).

MARK	GOODS/SERVICES	STATUS
E.MD	Electronic mail and message services comprising providing multiple user access to a global computer information network for the transfer and dissemination of electronic mail, messages, and data including x-rays, medical images, CT scans, MRI scans, and medical information; providing an electronic mail forwarding services for other wherein individuals may have electronic mail forwarded to a selected one of a plurality of addresses; providing receipt of faxes and voice mail using e-mail; forwarding electronic mail via fax or voice mail or pager; multi-media electronic mail services in connection with a subscription based on-line service.	Fed. Reg. No. 2,353,909

MARK	GOODS/SERVICES	STATUS
EMD-Q	Providing training programs, namely, conducting classes, seminars and workshops, in the field of quality management of emergency medical dispatching.	Fed. Reg. No. 2,378,268
EMD Pharmaceuticals	Full line of pharmaceuticals, diagnostic preparations for medical and clinical laboratory use and dietetic preparations, namely, dietary preparations, namely, dietary supplements, vitamins, nutritional supplements and food supplements.	Fed. Reg. No.2,726,395
EMD Oncology and Design	Pharmaceutical preparations; promotional, training educational and patient support materials, namely, books, pamphlets, newsletters, magazines, manuals, all featuring information in the field of cancer and conditions associated therewith.	Fed. Reg. No. 2,661,191
EMD	Full line of pharmaceuticals, diagnostic preparations for medical and clinical laboratory use and dietetic preparations, namely, nutritional supplements based on vitamins, minerals and probiotics and other nutritional supplements.	Fed. Reg. No. 2,739,522
EMD and Design	Membership in an association to advance the science of geology.	Fed. Reg. No. 1,400,756
EMD	Distributorship services in the field of audio and video products for others.	Fed. Reg. No. 675,543
E-M-D	Diesel locomotives and parts.	Fed. Reg. No. 1,940,246
EMD	Apparel and textile products.	Fed. Reg. No. 2,060,517

As is readily evident, the term EMD is not a unique or novel word, nor was it coined by Registrant. Said term and variations thereof have had extensive use as trademarks and has been federally registered numerous times in the field of health care. Additionally, Applicant has previously submitted into the record evidence as to the wide, third-party use of EMD formative marks in the medical and other fields. Examples illustrating third-party EMD use were provided in Applicant's March 19, 2002 Request for Reconsideration included services for pharmaceuticals (Exhibit 3), medical degree information (Exhibit 4), medical laboratory education and management (Exhibit 5), medical emergency dispatch (Exhibit 6), brain tumor testing (Exhibit 7), muscular dystrophy information (Exhibit 8), and medical

payment/informational databases for use by medical clinics (Exhibit 9). The Examiner has objected to Applicants evidence as not being in the same medical field as Registrant; however, like Applicant, the third-party usage comprises information provision in the medical and healthcare industry.

Given the numerous EMD co-existent registrations, it is clear that consumers are not confused as a result of the term EMD and that minor differences with respect to the marks and goods under which they are sold are sufficient to distinguish the marks as a whole from one another. This contention is strongly supported by the Trademark Office and the fact that they have permitted registrations incorporating the term EMD in the field of medicine, healthcare and science.

Determining that a mark is weak means that consumer confusion has been found unlikely because the mark's components are so widely used that the public can easily distinguish "slight differences" [emphasis added] in the marks even if the goods are related. *General Mills, Inc. v. Kellogg Company*, 824 F.2d 622 (8th Cir. 1987). See *Beech-Nut, Inc. v. Warner Lambert Co.*, 480 F.2d 801 (2nd Cir. 1973) wherein the trial court in denying preliminary injunctive relief sought by BREATH SAVERS against BREATH MINTS stated that even the smallest variations of a weak mark are enough to defeat an infringement claim.

Applicant respectfully draws the Board's attention to the fact that if the common element of conflicting marks is a word that is "weak" then this reduces likelihood of confusion. *Gruner & Jahr USA Publishing v. Meredith Corp.*, 26 USPQ.2d 1583 (2d Cir. 1993). Further illustrating the "weakness" of EMD is the substantial common use of the term by others for identical goods in the market. See EMD-Q for health related seminars (Fed. Reg. No. 2,378,268), EMD Oncology for magazines and books in healthcare (Fed. Reg. No. 2,661,191). A portion of a mark

is "weak" if it is in common use by others. *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970). Evidence of third party usage of similar marks on similar goods and services is admissible and relevant to show that a mark is relatively weak and entitled to a narrow scope of protection. *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259-60 (5th Cir. 1980). The greater the number of identical or more or less similar trademarks already in use, the less the likelihood of confusion. RESTATEMENT OF TORTS § 729, comment g. In essence, the term EMD is a "weak" mark and can be accorded only a narrow range of protection to its specific description of goods in its limited line of commerce.

E. Intent - Applicant Adopted its Mark in Good Faith.

Lastly, Applicant was unaware of Registrant during adoption of the Mark and at all times has adopted and prosecuted this application in good faith. At no time has it been Applicant's intent to capitalize on Registrant's reputation or goodwill. It is Applicant's position that even though Registrant's mark is registered, the presumption of an exclusive right to use the mark extends only to the goods and services noted in the registration certificate.


CONCLUSION

The Examining Attorney bears the burden of making out a persuasive case for finding that confusion among consumers or users of products and services is not merely a theoretical possibility but *is likely*. The instant case is predicated upon the assumption that Applicant will adopt Registrant's type style, the assumption that a common source would be deemed to offer the respective goods and services under the same mark, the assumption that Applicant's cyber services would fall into the natural zone of expansion of Registrant's brick and mortar business,

and the assumption that the respective goods and services would have overlapping channels of trade. In this case, the Examining Attorney has not carried the burden. Applicant's on-line services are not related to magazines and seminars, are non-competitive therewith and have little in common with respect to essential characteristics, uses or sales appeal. Applicant's Mark creates a different commercial impression when compared to Registrant's. For the reasons set forth herein, Applicant submits that its Mark is not likely to cause confusion within the meaning of Section 2(d) of the Trademark Act and the Examiner's decision should be reversed and Applicant's application passed to publication.

Respectfully submitted,
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